

REMARKS

I. Formalities

Applicant thanks the Examiner for considering the reference cited with the PTO/SB08/A&B(modified) form submitted along with the Amendment under 37 C.F.R. § 1.111 filed on June 10, 2005.

II. Status of the Application

By the present amendment, Applicant amends claims 1-13. Claims 1-13 are all the claims pending in the Application, with claims 1, 4, 8 and 11 being in independent form. Claims 1-13 have been rejected.

The present amendment addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

III. Claim Rejections under 35 U.S.C. § 112

A. 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

During a personal interview with the Examiner on November 29, 2005, Applicant's representative, Andrew J. Taska, discussed the above rejections under 35 U.S.C. § 112, first paragraph, with the Examiner and reached an agreement with the Examiner regarding the meaning of the term "locus data," as recited in the present application. More particularly, Applicant's representative explained the meaning of the term "locus data," and successfully pointed out to the Examiner how the specification discloses this meaning.

In response to the explanation provided by Applicant's representative, the Examiner indicated that if Applicant were to include a detailed discussion of the term "locus data" in the Remarks section of the response to the outstanding Office Action, then the Examiner would withdraw these rejections.

In accordance with the Examiner's request, Applicant hereby notes that the term "locus," as used in the present specification refers to, for example, a line traced by a point which varies its position according to some determinate law or, more particularly, a trajectory of present positions. Further, Applicant submits that one of ordinary skill in the art would understand that "locus data," as recited in claims 1-13, means trajectory data of the present locations. As such, Applicant submits that the term "locus data" is described in the present specification in a sufficient manner so as to enable one of ordinary skill to make and use the invention.

Accordingly, Applicant respectfully requests that the Examiner withdraw these rejections.

B. 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 1-13 under 35 U.S.C. § 112, second paragraph, as being generally narrative and indefinite and, thus, failing to conform with U.S. practice. Applicant has amended claims 1-13, as set forth above, to correct the informalities noted by the Examiner. Therefore, Applicant respectfully requests that the Examiner withdraw these rejections.

IV. Claim Rejections under 35 U.S.C. § 103

The Examiner was persuaded by Applicant's arguments advanced in the Amendment under 37 C.F.R. § 1.111 filed on June 10, 2005, that Cherveney fails to disclose or suggest a

server for updating road information in a map information providing system for providing desired road information in accordance with a request from each of terminal units, as recited in the pending claims. Nevertheless, the Examiner has set forth new grounds of rejection, citing an additional reference.

Specifically, the Examiner has rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Cherveney in view of U.S. Patent Publication No. 2004/0104842 to Drury et al. (hereinafter “Drury”). Applicant respectfully traverses these rejections for *at least* the reasons set forth below.

In response to Applicant’s previous arguments, the Examiner acknowledges that Cherveney fails to disclose or suggest a server for updating road information in a map information providing system for providing desired road information in accordance with a request from each of the terminal units. Indeed, the Examiner acknowledges that Cherveney only discloses that updates are distributed and does not teach or suggest whether the central station or the terminals initiate the updates. Nevertheless, the grounds of rejection apply Drury, alleging that Drury teaches or suggests this feature. Applicant respectfully disagrees with the grounds of rejection.

Contrary to the requirements of the MPEP, the grounds of rejection have not identified a proper motivation to combine the disparate teachings of Cherveney and Drury. The Examiner bears the initial burden of establishing *prima facie* obviousness. (MPEP § 2142). To establish a *prima facie* case of obviousness the Examiner must establish that there is some suggestion or motivation, in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. (See MPEP § 2143). In fact, in order to combine or modify reference(s), and establish a *prima facie*

case of obviousness, the Examiner must show by clear and particular evidence the motivation, suggestion or teaching to combine or modify the reference(s) and how or why such modification or combination is within the skill of one in the art. (*See, In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999)).

Here, the Examiner summarily alleges that it would have been obvious to one of ordinary skill in the art to use the teaching of Drury in the invention of Cherveney, to arrive at the recitations in claims 1-13, because such a modification would provide a way to initiate the updates disclosed in Cherveney. (08/25/05 Office Action, page 4). However, the mere fact that references can be “combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination [or modification].” (MPEP §2143.01).

The bald allegation that “such a modification would provide a way to initiate the updates disclosed in Cherveney,” merely alleges that the teachings of Drury and Cherveney can be combined. However, such an unsupported allegation, without more, does not show by clear and particular evidence a motivation for making such a combination, as required by the MPEP.

Furthermore, Applicant submits that, in fact, there is no motivation in either the references themselves, or in the knowledge generally available in the art, for one of ordinary skill to combine the teachings of Drury with those of Cherveney in the manner proposed by the grounds of rejection. To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (*In re Kotzab*, 55 USPQ2d at

1316 (*citing In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984))).

Drury merely teaches a driver information system which provides a rerouting technique with respect to the existing roads and the existing traffic conditions and which updates positions or traffic information along a predetermined route. (*See e.g.*, Abstract; paragraph 0350). However, Drury provides no teaching or suggestion whatsoever regarding the desirability of combining the teachings therein with those of Chervený so as to perform the entirely different operation of updating brand-new roads, or the feature of road network data which is updated by the positional data of the terminals, as recited in claims 1-13. Therefore, Applicant submits that there is no motivation to combine the teachings of Drury with those of Chervený as proposed in the grounds of rejection.

Consequently, Applicant respectfully submits that claims 1-13 are patentable over the applied references for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/899,088

Attorney Docket No. Q65341

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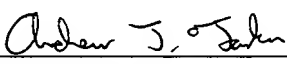
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